

REMARKS

Applicant respectfully requests reconsideration of this application as amended. Claims 1-25 are pending in the application. No claims have been amended or canceled.

The Examiner rejected claims 1-6, 10-16, and 20-25 under 35 U.S.C. §103(a) as being unpatentable over Magnus et al. (WO 02/082359; hereinafter "Magnus") as modified by Zdybel, Jr. et al. (U.S. Patent No. 5,486,686; hereinafter "Zdybel").

Applicant respectfully traverses the rejection.

Claim 1 as amended sets forth "**automatically** sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system **at one or more predetermined time without user intervention**" (claim 1, emphasis added). In contrast, Magnus does not disclose automatically sending edits to a computer system at one or more predetermined time without user intervention.

According to Magnus:

When the **desired** amount of written information has been stored in the memory, this can be transmitted at an **optional** time and be sent on wirelessly via a transmitter 7 which in a preferred embodiment is a so-called Bluetooth® transmitter.

(Magnus, p. 7, lines 28-32; emphasis added)

The Examiner quoted the above section from Magnus and requested Applicant to further review Magnus by giving its broadest reasonable interpretation. Applicant respectfully complies and submits that the above passage from Magnus does not disclose, suggest, or imply **automatically** sending the edits via a wireless transmission. To the contrary, "**optional**" means not **automatic** according to Webster's II New College Dictionary (published by Houghton Mifflin Company, © 2001). The word "optional" quantifies the word "time" and therefore, the time at which the information

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may be sent is selectable, and thus, not automatic. Therefore, at best, Magnus does not disclose automatically sending the edits; at worst, Magnus teaches away from the present invention as claimed.

Furthermore, claim 1 as amended teaches that the edits are sent *without user intervention*. In contrast, the apparatus disclosed in *Magnus requires user intervention* to send data to a computer system. For example, Magnus discloses that a user has to **actuate** a send button, to **move** the writing and reading unit across a specific place, or to **mark** a specific send box on the coupon in order to send information from the writing and reading unit (Magnus, p. 3, lines 8-17; p. 8, lines 15-17). Also, neither does the passage from Magnus quoted above disclose or suggest sending edits without user intervention. Therefore, **reading Magnus as a whole**, Magnus teaches away from sending the edits without user intervention.

Moreover, Zdybel does not overcome the deficiencies of Magnus. Zdybel does not disclose "automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system at one or more predetermined time without user intervention." Since the combination of Magnus and Zdybel does not disclose every limitation in claim 1, they do not render claim 1 obvious under §103(a). Applicant respectfully requests the Examiner to withdraw the rejection.

Since Magnus and Zdybel do not disclose every limitation in claim 1, it is not necessary to discuss whether one of ordinary skill in the art would be motivated to combine Magnus and Zdybel, and therefore, this issue is not discussed here. However, Applicant reserves the right to argue this issue in the future.

Claims 2-13 depend, directly or indirectly, from claim 1. For at least the reason discussed above with respect to claim 1, claims 2-13 are patentable over Magnus in view of Zdybel. Applicant respectfully requests the Examiner to withdraw the rejections.

Regarding claim 5, claim 5 recites **incorporating the one or more changes into an electronic version of the hardcopy representation**. In contrast, neither Magnus nor Zdybel discloses such a limitation. The Examiner did not specifically point out how and where in Magnus or Zdybel discloses the above limitation. Applicant does not believe such a limitation is met by the disclosure of Magnus and Zdybel. Applicant respectfully requests the Examiner to withdraw the rejection or to specifically point out in the references where the limitation is disclosed.

Claim 6 further recites incorporating the one or more changes into an electronic version of the hardcopy representation **automatically without end user intervention through the use of a pen/paper interface**. In contrast, neither Magnus nor Zdybel discloses such a limitation. The Examiner did not specifically point out how and where in Magnus or Zdybel discloses the above limitation. Applicant does not believe such a limitation is met by the disclosure of Magnus and Zdybel. Applicant respectfully requests the Examiner to withdraw the rejection or to specifically point out in the references where the limitation is disclosed.

Applicant respectfully submits that claims 14 and 24 are patentable over Magnus in view of Zdybel for at least the reason discussed above with respect to claim 1. The Examiner is respectfully requested to withdraw the rejections.

Claims 15-23, and 25 depend, directly or indirectly, from claims 14 and 24 respectively. Therefore, claims 15-23, and 25 are patentable over Magnus in view of Zdybel for at least the reason discussed above with respect to claims 14 and 24.

With respect to claims 7-9, and 17-19, the Examiner rejected them under 35 U.S.C. §103(a) as being unpatentable over Magnus, as modified by Zdybel as applied to claim 1, and further in view of Patton et al. (U.S. Patent No. 5,757,468; hereinafter "Patton"). For the reasons discussed above with respect to claim 1, and at least one additional reason, Applicant respectfully traverses the rejection.

Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine Patton with Magnus and Zdybel to arrive at the present invention as claimed in claims 7-9, and 17-19. Patton is directed to *associating sound with still images* (Patton, column 1, lines 15-20), not updating an electronic application with edits made to hardcopy representations of the electronic application. Applicant respectfully submits that Patton is directed to a distinct and separate problem from the one solved by the present invention as claimed, and therefore, one of ordinary skill in the art would not have been motivated to look to Patton for a solution to the problem identified in the present application.

However, the Examiner argued in the Final Office Action that it would have been obvious to combine Patton with Magnus as modified by Zdybel "in order to provide a visual acknowledgement of the information (i.e. ID) printed with an icon to the operator to further offer an aesthetic appeal to the hard copy." (Final Office Action, p. 4, third paragraph). Applicant respectfully submits that aesthetic appeal is not an issue in either Magnus or Zdybel and neither Magnus nor Zdybel expresses any concern on aesthetic appeal of the hard copy. Therefore, one of ordinary skill in the art would not have any motivation to combine Magnus and Zdybel with Patton. Applicant respectfully submits that the present invention as claimed is not obvious in view of Magnus, Zdybel, and Patton. Applicant respectfully requests the Examiner to withdraw the rejection under §103(a).

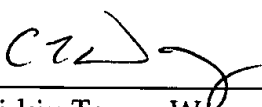
Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been overcome by the remarks and withdrawal of these rejections is respectfully requested. Applicant submits that claims 1-25 as amended are now in condition for allowance and such action is earnestly solicited.

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Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

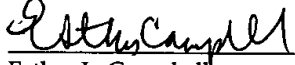
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